

Appl. No. 09/641,535
Reply dated September 14, 2005
Reply to Office Action mailed October 15, 2004
Attorney Docket No. 2101785-991100

REMARKS

Claims 1- 51 are pending. Claims 1, 10, 16, 21, 27, 32, 36, 42 and 47 have been amended, no claims have been cancelled and no claims have been newly added so that Claims 1-5, 7-12, 14-17, 19, 21-23, 25-27, 29-30, 32-36, 38-9, 41-7 and 49-51 are pending after this response. Reconsideration is respectfully requested.

Applicant submits this response with a request for continued examination (RCE). Applicant wishes to thank the Examiner for the telephonic interview.

PRIOR ART REJECTIONS

In response to the Examiner rejection of Claims 1-5, 7, 10-12, 14-17, 19, 21-23, 25-27, 29-36, 38-39, 41-44, 47, 49 and 51 under 35 USC 103 as being unpatentable over U.S. Patent No. 5,925,127 to Ahmad (hereinafter "Ahmad") in view of U.S. Patent No. 5,953,005 to Liu (hereinafter "Liu") and further in view of U.S. Patent Publication No. 2003/0040962 to Lewis (hereinafter "Lewis"), claims 8-9 and 45-6 under 35 USC 103 as being unpatentable over Ahmad, Liu and Lewis and further in view of U.S. Patent No. 6,327,579 to Crawford (hereinafter "Crawford"), Applicant respectfully traverses the rejections. In particular, the prior art cited by the Examiner does not render the current claims of the patent obvious for the reasons set forth below. Therefore, early allowance of the claims is respectfully requested.

Claims 1, 10, 16, 21, 27, 32, 36, 42 and 47

The Examiner has rejected these independent claims as being obvious over Ahmad in view of Liu and further in view of Lewis. However, the combination of Ahmad, Liu and Lewis does not disclose or suggest every claim element. In addition to the prior arguments made in prior responses that are incorporated herein by reference, the claims are allowable over Ahmad, Liu and Lewis at least because each independent claim recites "a process manager means further comprising means for creating and running a process corresponding to the main executable file without installing the rental software program on the user computer system and means for suspending the process if the process requests one or more optional files" or a similar element which is not disclosed by the combination of prior art cited by the examiner. In the claimed invention, the process manager means creates and runs a process corresponding to the main executable file so that the rental software

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program (including at least the main executable file) is not installed on the computer system. This aspect of the claimed invention is not shown or suggested by the combination of prior art cited by the examiner because the prior art does not disclose a system in which a rental software program may be executed without installing the rental software program (including at least the main executable file) on the computer system. During the recent telephonic interview, Applicant's attorney and the examiner agreed that a software program must be installed on a computer system in order to be executed. In the case of the claimed invention, the process manager means (which is distinct from the software rental program including at least the main executable file) is installed so that it can be executed while the main executable file and optional files do not need to be installed since it is executed as a process by the process manager means and does not need to be installed on the computer. In the case of Ahmad, the program module 100 is installed on the computer 20 and executed to implement the rental software. See Col. 10, lines 35-37. Ahmad does not disclose a system in which a main executable file of the rental software program is not installed and is in fact run as a process by the process manager means.

Furthermore, during the telephonic interview, the examiner suggested that the CICO module or software monitor module could be the claimed process manager means. However, the program module of Ahmad (that corresponds to the claimed main executable file) is not executed as a process by the software monitor module or CICO module so that the software monitor module or CICO module cannot be the claimed process manager module. In fact, the program module, software monitor module and CICO module each are executed at different times during the software rental process in Ahmad. See generally Figures 5A and 5B that show that process. See also Col. 10, lines 35- 37 that explicitly discloses that the CICO module 120 must be run on the user's computer prior to running the rented program module 100 on the user's computer. In addition, with respect to the CICO module, it is erased once used so it cannot be the process manager means that must be operating during the entire rental software process. See Col. 10, lines 62-67. The software monitor module tracks usage using an internal timer (See Col. 11, lines 14-35), but does not execute a process that corresponds to the main executable file as set forth in the claims. Ahmad makes it clear that the software monitor module is loaded by the program module (See Col. 11, lines 1-4) so that the software monitor module cannot be the claimed process manager means. Thus, Ahmad does not

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disclose the claimed process manager means nor the function to being able to run the rental software without installing the rental software program (contrasted with the process manager means) on the user computer. Liu also do not disclose that the main executable file (which corresponds to the song applet) is executed by a process manager or that the Liu system works with the song applet not being installed on the computer. Finally, Lewis discloses a VPR/DMS 45, but does not discuss that a main executable file does not need to be installed on the computer.

Motivation to Combine

Furthermore, in order to establish a prima facie case of obviousness, the examiner must establish that all of the claims limitations are taught by the prior art. This requirement of a prima facie obviousness rejection has not been met as discussed above. The examiner must also point to some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Fine*, 5 USPQ 2d 1596 (Fed. Cir. 1988). In addition, the mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Frutch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-4 n.14 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Furthermore, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983).

With the combination of Ahmad, Liu and Lewis, the examiner cannot establish a motivation to combine these references for at least two reasons. First, there is no objective showing of the desirability to combine Lewis with Ahmad and Liu. Second, Ahmad teaches away from the proposed combination. With respect to the first point, the examiner states at page 4 of the office action that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Ahmad and Liu to include Lewis' inventive concept wherein the process manager flushes the main executable and optional files of the rental program from the user computer system when the rental is completed." The examiner then states that "this would ensure that the user would not use the program for any additional time" as the desirability for the combination. However, Ahmad in fact teaches away from the combination as detailed below so

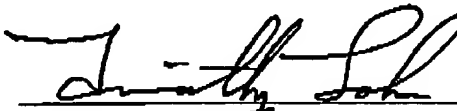
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that there is no showing of the objective desirability of the combination. In addition, none of the other prior art discloses the desirability of the combination of Ahmad, Liu and Lewis.

To the second point, Ahmad in fact teaches away from the proposed combination. In particular, Ahmad discloses that the program module (corresponding to the claimed main executable file) is maintained on the user's computer between rentals. See Col. 11, lines 60-62. The software monitor module is also not flushed from the user computer for each rental. See Col. 11, line 66 – Col. 12, line 10. In Ahmad, the CICO module 120 (in combination with the software monitor) controls the use of the rental program and is downloaded each time the program module is subsequently rented. See Col. 11, lines 62-65. Therefore, Ahmad discloses that the CICO module (in combination with the software monitor) is used to control the use of the program so that there is no need to flush the main executable file and optional files of the rental program to ensure that the user does not use the program for additional time as asserted by the examiner. Thus, Ahmad teaches away from the proposed combination since Ahmad does not need to flush the program module as shown in Lewis and therefore there is no motivation to combine Ahmad, Liu and Lewis together.

Respectfully submitted,

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Timothy W. Lohse
Reg. No. 35,255
Attorney for Applicants

DLA PIPER RUDNICK GRAY CARY US LLP
2000 University Avenue
East Palo Alto, CA 94303-2248
Telephone: (650) 833-2055